

REMARKS/ARGUMENTS

In response to the office action dated February 12, 2004, applicants respectfully request reconsideration based on the above claim amendments and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1-22 were rejected in the office action. Claims 1, 8, 18 and 22 have been amended. No claims have been canceled or added. Therefore, following entry of the present response, claims 1-22 will remain pending in the present application.

Applicants would like to thank Examiner Keith Ferguson for agreeing to conduct a telephonic interview on April 26, 2003. Applicants would also like to thank Examiner Ferguson for allowing applicants to discuss the novelty of the present application (and specifically with regard to claim 1) in light of the presently asserted prior art. Although agreement as to exact claim amendments was not reached, applicants' discussion was helpful in facilitating and progressing the prosecution of the present application.

Claims 1-6, 18-20 and 22 stand rejected under 35 U.S.C. § 102 (e) as allegedly being anticipated by U.S. Patent No. 6,343,123 to Lehmacher *et al.* ("Lehmacher"). More specifically, the office action suggests that Lehmacher discloses, *inter alia*, "connecting an out-of-market customer to a desired telephone number (***toll free universal number***) (col. 2 lines 5-65)." (Office Action dated February 12, 2004 at p. 2) (emphasis added). Applicants have amended claims 1, 8, 18 and 22 to make explicit that which previously was implicit; namely, that the desired destination telephone number is a toll call for the out-of-market customer.

Briefly, the present invention provides a creative and novel solution to a problem created by "roaming" mobile telephones. When mobile telephones "roam" outside of their

“home” market they are at the mercy of a “foreign” market provider to complete a call. As a result, additional costs may be added to the call by the foreign market provider. Typically, when a roaming mobile customer enters a toll-based telephone number (*i.e.*, a call that requires a toll charge) and hits the “send” button, a foreign mobile switching center (MSC) verifies the call with the customer’s home MSC. In particular, the foreign MSC receives a signal and then sends a message to the customer’s home MSC to validate the caller and to make sure that the foreign provider will be compensated for handling the “roaming” call. The validating message also includes the telephone number that the customer wishes to call.

The present invention provides a novel technique for avoiding such additional costs. When the foreign MSC sends a validation request to the home MSC, instead of simply validating the number, the home MSC is set up to return a toll-free number (*e.g.*, an “800” telephone number) to the foreign MSC. As a result, instead of completing the call, the foreign market provider routes the “800” telephone number back to the home market’s network, as it does with all toll-free numbers. The home market receives the “800” number and is set up to recognize that the number is really an attempt by its out-of-market customer to dial the toll-based number. Therefore, the home market converts the “800” number to the toll-based number, and completes its customer’s call. Notably, the call is completed by the home market and the only participation by the foreign market is not to complete the call, but to forward a cost free call to the home market’s network.

This feature is found in amended claim 1, for example, which recites a method of connecting an out-of-market customer to a desired telephone number. The inventive method provides a toll-free telephone number to a foreign market provider after receiving a customer validation request. The call request is then directed from the foreign market provider to the

desired telephone number, where the desired telephone number is a toll-based call with respect to the out-of-market customer. Support for the amendment to claim 1 is found throughout the present specification, and particularly where it states: ““Registration request return”” message includes the verification along with desired DN 220. Once foreign MSC 103 receives the ““registration notification result”” message it may bill the call accordingly. (*Specification* – page 11, lines 1-4)..

Lehmacher, on the other hand, does not allow an out-of-market customer to avoid costs placed by the foreign market provider. Instead, Lehmacher simply allows an out-of-market customer to dial a toll-free universal number. The examiner is respectfully requested to recognize the difference between allowing a user to dial a universal international toll-free phone number in an international numbering area and the present invention.

Accordingly, withdrawal of the rejection of claims 1-6, 18-20 and 22 under 35 U.S.C. § 102 (e) over Lehmacher is believed proper and respectfully solicited.

Also, claims 7 and 17 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lehmacher in view of WO 00/27144 to Valsa *et al.* (“Valsa”). Applicants respectfully assert that claims 7 and 17 are distinguished over the teachings of Lehmacher in view of Valsa for the same reasons discussed above with respect to the rejection of claims 1-6, 18-20 and 22 under 35 U.S.C. § 102 (e) over Lehmacher. Accordingly, withdrawal of the rejection of claims 7 and 17 under 35 U.S.C. § 103 (a) as being obvious over Lehmacher in view of Valsa is believed proper and respectfully solicited.

In addition, claims 8, 9 and 12-16 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lehmacher in view of in view of U.S. Patent No. 6,345,182 to Fabritus *et al.* (“Fabritus”). Applicants respectfully assert that claims 8, 9 and 12-16 are distinguished

over the teachings of Lehmacher in view of Fabritus for the same reasons discussed above with respect to the rejection of claims 1-6, 18-20 and 22 under 35 U.S.C. § 102 (e) over Lehmacher. Accordingly, withdrawal of the rejection of claims 8, 9 and 12-16 under 35 U.S.C. § 103 (a) as being obvious over Lehmacher in view of Fabritus is believed proper and respectfully solicited.

Claims 10 and 11 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lehmacher in view of Fabritus and in further view of U.S. Patent Application No. 2003/0185373 to Boughman *et al.* ("Boughman"). Applicants respectfully assert that claims 10 and 11 are distinguished over the teachings of Lehmacher in view of Fabritus and Boughman for the same reasons discussed above with respect to the rejection of claims 1-6, 18-20 and 22 under 35 U.S.C. § 102 (e) over Lehmacher. Accordingly, withdrawal of the rejection of claims 10 and 11 under 35 U.S.C. § 103 (a) as being obvious over Lehmacher in view of Fabritus and Boughman is believed proper and respectfully solicited.

Finally, claim 21 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lehmacher in view of U.S. Patent Application No. 2004/0005874 to Malackowski *et al.* ("Malackowski"). Applicants respectfully assert that claim 21 is distinguished over the teachings of Lehmacher in view of Malackowski for the same reasons discussed above with respect to the rejection of claims 1-6, 18-20 and 22 under 35 U.S.C. § 102 (e) over Lehmacher. Accordingly, withdrawal of the rejection of claim 21 under 35 U.S.C. § 103 (a) as being obvious over Lehmacher in view of Malackowski is believed proper and respectfully solicited.

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PATENT

CONCLUSION

In view of the foregoing, applicants respectfully submit that the claims are allowable and that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Vincent J. Roccia at (215) 564-8946, to discuss resolution of any remaining issues.

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